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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/936,944 | 09/20/2001 | Thierry Sert | 05221.00003 | 3072 |
| 22907 7590 09/10/2007 BANNER & WITCOFF, LTD. 1100 13th STREET, N.W. SUITE 1200 WASHINGTON, DC 20005-4051 | | | EXAMINER BEKERMANN, MICHAEL | |
| | | | ART UNIT 3622 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/936,944

Applicant(s)

SERT ET AL.

Examiner

Michael Bekerman

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 14, 16-23 and 25-29 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 14, 16-23 and 25-29 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/1/2007 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. **Claims 14, 22, and 29 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.**

Regarding claims 14, 22, and 29, these claims recite the limitation "showing graphically the state of fulfillment of a bonus from zero to completion". The portion of this language that recites "the state of fulfillment" lacks antecedent basis. Further, the portion which recites "from zero to completion" is unclear. No complete point is mentioned in the claim. Are there multiple tiers of obtainable rewards? Does the

graduated scale only show "the state of fulfillment" up to a first-tier completion? What signifies this completion point?

Claim Rejections - 35 USC § 103

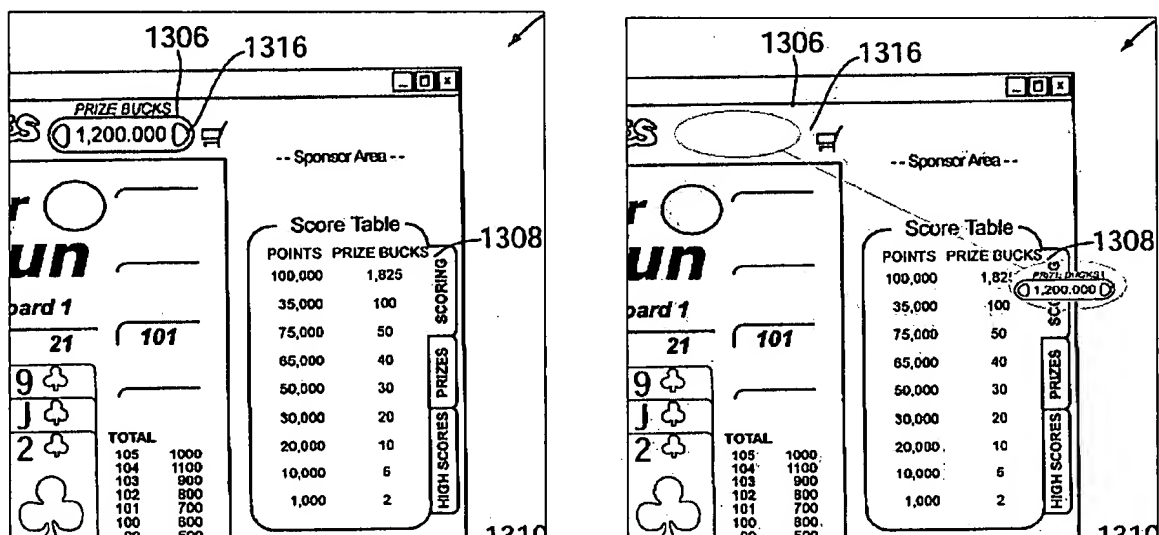
The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. **Claims 14, 16, 17, 21-23, and 25-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,889,198) in view of Kelly (U.S. Patent No. 6,293,865).**

Regarding claims 14, 16, 22, 23, 25 and 27-29, Kawan teaches a means for reading coded data from the memory of a smart card (Figure 1, Reference 16), storage means (Figure 1, Reference 6, and Column 5, Lines 1-3), calculating means (updating and formatting for display, the displaying of any information on the card is taken to read on uniform display) (Column 5, Lines 35-38), data-display means (Figure 1, Reference 10), data registers (Column 6, Lines 6-10), several different merchants (Column 2, Lines 18-20), several loyalty programs (Column 6, Lines 15-18), and means for navigation (Column 5, Lines 7-9). Kawan teaches displaying of different products and the respective amounts of loyalty points required to obtain each product (Column 7, Lines 45-48). Kawan doesn't teach displaying that information in the format of a graded scale.

Kelly teaches a gaming system that totals performance and gives a reward based on that performance. Figure 13, Reference 1308 shows a graduated scale of number of points earned through the game, and the number of prize bucks that those points are exchangeable for. Reference 1306 of that same figure shows the total amount of prize bucks earned up to that point. Examiner considers the entirety of Figure 13 to be a graduated scale, and thus the amount of prize bucks in Reference 1306 is considered to be part of the graduated scale. Since the prize bucks are inherently updated dynamically, the graduated scale is updated. It could also, however, be argued that Figure 13 in its entirety is not a graduated scale, but a screen that comprises a graduated scale separate from the amount of bonus points earned so far. By either interpretation, It would still have been obvious to one having ordinary skill in the art at the time the invention was made to display prizes available along with the amount of points needed to obtain an item and to display a marker indicating current performance on the same prize display (See figures below).



The images above display taking the prize bucks counter and moving it to the applicable position on the graduated scale. Seeing as how this type of display is old and well-known for charities to use (to show how much money a cause has generated up to that point), those skilled in the art would have been capable of and found it obvious to display the graduated scale in the format shown. This would give the consumer a better impression of how many award points they have and what prizes those points could be redeemed for (in the case of Kelly, to better help those customers who have trouble linking their point total to where they stand on the graduated prize scale). The calculations of claim 16 are seen as inherent calculations in obtaining current scale level and interval distance.

With regard to the specific data content that is displayed ("said data corresponding to at least two types of bonus counters taken among frequency of visits, recency of visits, cumulative amount spent, and promotion points"), it could be argued that Kawan does not teach all of such specific data content. However these differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of data content. Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see In re Gulack, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); In re Lowry, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have displayed any type of bonus data

content. Such data content does not functionally relate to the steps and the subjective interpretation of the data content does not patentably distinguish the claimed invention.

Regarding claim 17, Kawan teaches the navigation means as being a touch screen (Column 5, Lines 10-11).

Regarding claims 21 and 26, Kawan teaches comparing data input with data stored and displaying the results of this comparison in order to keep information updated (Column 6, Lines 56-66).

4. **Claims 18-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kawan (U.S. Patent No. 6,889,198) in view of Kelly (U.S. Patent No. 6,293,865), and further in view of Fox (U.S. Patent No. 5,943,624).**

Regarding claims 18-20, Kawan teaches a smart card interacting with a kiosk to display loyalty points. Kawan doesn't teach a portable phone, satellite decoder, or PDA. Fox teaches a cell phone that communicates, displays, and updates information from a smart card (this cell phone is taken to inherently include GPS technology, which reads on the satellite decoder) (Column 2, Lines 21-29). Official notice is taken that wireless PDA telecommunication technology is old and well known in the art. It would have been obvious to one having ordinary skill in the art at the time the invention was made to not only display the contents of the smart card loyalty registers on the terminal of Kawan, but to allow display of the smart card on other devices as well for greater comfort and flexibility.

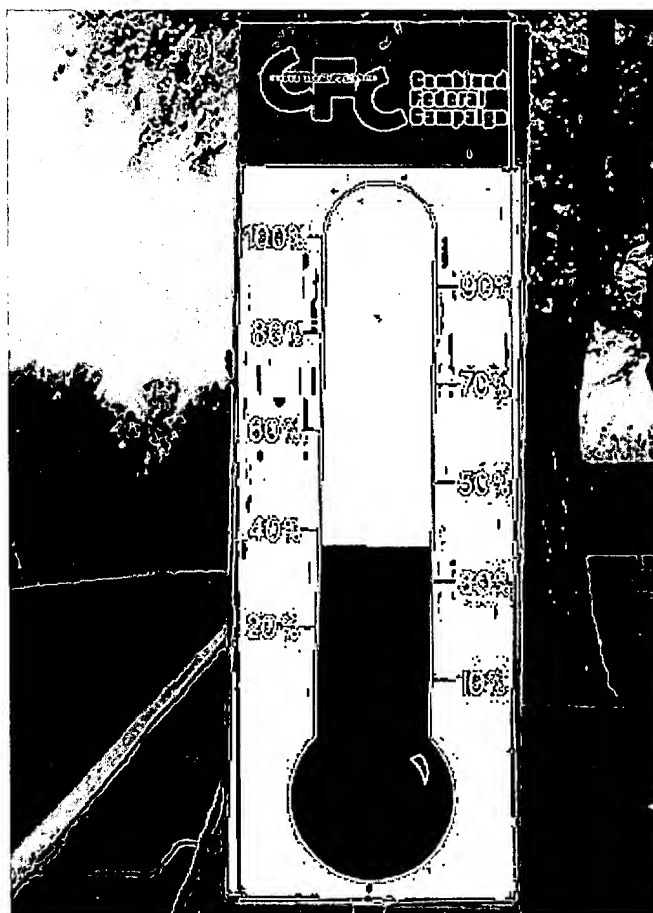
Response to Arguments

5. Applicant argues that Kawan and Kelly do not display a graduated scale based on at least two types of bonuses. The displayed data, however, is non-functional descriptive material. The claim reads "said data corresponding to". It does not matter what the data corresponds to. The displayed data itself does not change the functionality of the invention, and it would be obvious to display whatever information would be necessary in this case.

6. Applicant further argues "Figure 13 of Kelly is not a graduated scale as argued by Examiner; it is a game user interface that contains a graduated scale and other interface components that are dynamically updated". Examiner does not entirely agree with this statement. Whether the prize bucks are displayed at a certain place beside or on top of the graduated scale (which is a simple task of moving the displayed number to a different area of the screen), or in a different corner of the screen is irrelevant. The entire screen could be taken to be the graduated scale, or the distinct portion could be considered the graduated scale. Regardless of this, the rejection has been amended to take both of these interpretations into account.

7. Applicant further argues "the Office Action has failed to identify a reason why a person skilled in the art would combine Kawan, a system for tracking and updating loyalty points, with Kelly, which relates to a tournament network gaming system and has nothing to do with merchant loyalty programs". Examiner is simply using Kelly to teach the graduated scale. Dynamically updating graduated scales are old and well-known ways of displaying information. As explained in the rejection above, one example is

how charities have used this device for years to show the amount of revenue generated for a cause up to the date. Here is an image illustrating a CFC fund raiser that uses a graduated scale (that is dynamically updated as needed):



Seeing as how a graduated scale was not invented by Applicant, an argument of impermissible hindsight to come to a conclusion of obviousness in this instance is not seen as being persuasive. Examiner could have used a graduated scale from any field to reject this limitation.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Bekerman whose telephone number is (571) 272-3256. The examiner can normally be reached on Monday - Friday, 7:30 - 3:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric W. Stamber can be reached on (571) 272-6724. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MB



**JEFFREY D. CARLSON
PRIMARY EXAMINER**